

### REMARKS

This application was originally filed on 13 October 1998, 1997 with forty two claims, five of which were written in independent form. Claims 20, 41 and 42 were canceled, and Claim 28 was amended on 9 May 2003. Claim 30 has been amended herein, and Claims 43- have been added. Claims 1-19 and 21-24 are allowed. Claims 25-40 have been rejected.

The Examiner made the Office Action mailed 20 February 2004 final. The applicant respectfully submits that the finality of the rejection is improper and requests that it be withdrawn.

Section 706.07(a) of the MPEP states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). . . .

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

The Examiner stated, "Applicant's arguments filed on 1/21/2004 have been fully considered but they are moot in view of new ground (s) of rejection." As the applicant did not amend the claims or file an information disclosure statement, and the new rejection, which the Examiner admits is a new ground of rejection, was based on newly discovered art found in a new search by the Examiner, the finality of the rejection is improper and should be withdrawn.

Claim 25 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,117,605 to Kurland *et al.* ("Kurland"). The applicant respectfully disagrees.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35

U.S.C. § 102 that, “a person shall be entitled to a patent unless,” concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham and Adams*.” *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). “As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the ‘burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103’.” *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

“The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it.” *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

The applicant respectfully submits the Examiner has failed to meet the burden of proof required to establish a *prima facie* case of anticipation. Section 2131 of the Manual of Patent Examiner’s Procedure provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053, (Fed. Cir. 1987). . . . “The identical invention must be shown in as complete detail as contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as in the claim under review . . . . *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

With respect to independent Claim 25, the Examiner has failed to present any teaching in Kurland that the media is a “digital storage medium for storing digital data” as recited by Claim 25. Kurland teaches away from the use of a digital storage medium by utilization of a “conventional multitrack magnetic playback head 34” “operatively connected to” “a conventional

four channel audio amplifier 36.” (Column 6, lines 53-54 and column 7, lines 10-12.) As Kurland does not show, teach, or suggest a “digital storage medium for storing digital data” as recited by Claim 25, Kurland cannot be held to anticipate Claim 25 and the Examiner’s rejection is unsupported by the prior art, fails to establish a prima facie case of anticipation, and therefore is defective and should be withdrawn.

Claim 31 was rejected under 35 U.S.C. § 102(b) as being anticipated by Kurland. The applicant respectfully disagrees.

The Examiner has failed to present any teaching in Kurland suggesting “writing digital data onto a digital storage medium” as recited by Claim 31. Kurland teaches away from the use of a digital storage medium by utilization of a “conventional multitrack magnetic playback head 34” “operatively connected to” “a conventional four channel audio amplifier 36.” (Column 6, lines 53-54 and column 7, lines 10-12.) As Kurland does not show, teach, or suggest a “writing digital data onto a digital storage medium” as recited by Claim 31, Kurland cannot be held to anticipate Claim 31 and the Examiner’s rejection is unsupported by the prior art, fails to establish a prima facie case of anticipation, and therefore is defective and should be withdrawn.

Claim 38 was rejected under 35 U.S.C. § 102(b) as being anticipated by Kurland. The applicant respectfully disagrees.

Claim 38 recites, “storing usage information concerning said reading step on said storage media; and transmitting said information to an information collection agency.” The Examiner has failed to attempt to read Kurland on the above recited limitations of Claim 38. The Examiner’s rejection therefore is unsupported by the prior art, fails to establish a prima facie case of anticipation, and therefore is defective and should be withdrawn.

Claims 25-27, 29, 30, 32-37, 39 and 40 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kurland. The applicant respectfully disagrees.

Claims 25-27, 29, 30, 32-37, 39 and 40 depend from independent Claims 25, 31, and 38 and should be deemed allowable for that reason and on their own merits. For the reasons argued above with respect to the independent claims, the Examiner has failed to present a prima facie case of anticipation, as required by law, with respect to the independent claims, much less with respect to the limitations of the independent claims in combination with the additional limitations

of the dependent claims.

Newly added independent Claims 43 and 48 recite embodiments similar to independent Claims 25 and 31 and should be deemed allowable for that reason and on their own merits. Additional support for the limitations of Claims 43 and 48 is provided in the specification on line 4 of page 13 through line 4 of page 14. Newly added dependent Claims 44-47 and 49-53 recite embodiments similar to dependent Claims 26, 29, 30, and 32, 33, and 35-37.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the present claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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